

REMARKS

Summary of the Office Action

Claims 1-3, 8, 10, 13, 16, and 21-24 are pending in this application.

Claims 1-3, 8 and 21 have been rejected as obvious over U.S. Patent No. 6,120,534 to Ruiz (“*Ruiz*”) in view of European Patent No. 0 779 062 to Glastra et al. (*Glastra*”).

Claims 1-3, 8, 13, 16, and 23-24 have been rejected as obvious over *Glastra* in view of German Patent No. 195 09 464 to Jäger (“*Jäger*”).

Claim 10 has been rejected as obvious over *Glastra* in view of *Jäger* and further in view of U.S. Patent No. 5,695,498 to Tower (“*Tower*”).

Claim 22 has been rejected as obvious over *Glastra* in view of *Jäger* and further in view of U.S. Patent No. 5,843,116 to Crocker (“*Crocker*”).

Response to the Office Action

Claims 1-3, 8, 10, 13, 16 and 21-24 are pending in the application. Claims 1 has been amended to import the limitations of claim 13, and claim 13 has been canceled. Therefore, upon entry of the present amendment, claims 1-3, 8, 10, 16 and 21-24 will be subject to examination.

The Examiner’s rejection of the pending claims are based on alleged obviousness in view of the cited references. A prima facie case of obviousness requires: (1) a reason to combine; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claim limitations in the prior art. *Brown & Williamson Tobacco Corp. v. Philip Morris*, 229 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Regal*, 526 F.2d 1399, 1403 (C.C.P.A. 1975).

The rejection of independent claim 1 of and the claims depending thereon is respectfully traversed at least for the reasons detailed in the following sections.

A. The Rejection of Claims 1-3, 8 and 21 over *Ruiz* in view of *Glastra*

The rejection of claims 1-3, 8 and 21 over *Ruiz* in view of *Glastra* is traversed because *Ruiz* and *Glastra*, alone or in combination, do not teach all the elements of independent claim 1 and of the claims depending therefrom, and because there is no reason for a person skilled in the art to combine the cited references, indicating that the Examiner’s rejection is based on

impermissible hindsight.

Ruiz teaches a stent with a ring-like section of reduced diameter obtained by expanding two balloons at opposite ends of the stent. Therefore, *Ruiz* does not teach expansion with a single balloon, as the Examiner has admitted. *Glastra* instead teaches stent expansion with a single balloon, but does not teach using a balloon having a stiffening element. Therefore, the combination of *Ruiz* and *Glastra* do not teach all the limitations of independent claim 1 or of the claims depending therefrom.

Applicant also notes that *Ruiz* expressly requires that stent expansion be performed with two opposing balloons, contrary to the teachings of *Glastra*, which had been published before *Ruiz*. Therefore, *Ruiz* elected not to employ the expansion method of *Glastra*.

Applicant further notes that one of the problems solved by Applicant's invention is blood turbulence as blood exits the stent section of reduced diameter (see, e.g. paragraph [0008] of the published specification), while the design of *Ruiz*, lobed and with sharply changing cross-section, is prone to turbulence. *Glastra*, on the other hand, teaches to a stent that supports a vessel in the proximity of a tumor, and is not concerned with blood turbulence, which is not even mentioned by *Glastra*. Therefore, there is no reason why a person of ordinary skill in the art would have removed a main design element of *Ruiz* (which was developed after *Glastra*) and introduced in its place a design feature of *Glastra*, when neither reference – particularly *Glastra* - addresses blood turbulence. For the foregoing reasons, Applicant submits that the proposed combination of *Ruiz* and *Glastra*, even if such a combination were possible, can be based only on impermissible hindsight by the Examiner.

B. The Rejection of Claims 1-3, 8, 13, 16, and 23-24 over *Glastra* in view of *Jäger*

The rejection of claims 1-3, 8, 13, 16, and 23-24 over *Ruiz* in view of *Glastra* is respectfully traversed because *Ruiz* and *Glastra*, alone or in combination, do not teach all the elements of independent claim 1 and of the claims depending therefrom

Glastra has been discussed above. The Examiner has admitted that *Glastra* does not teach the use of a stiffening element to form the essentially tubular segment of reduced expandability. The Examiner has characterized *Jäger* as teaching a stiffening element for forming a reduced expandable section. *Jäger*, however, teaches that “Die Einshnürung 5 kann beispielweise von einem eng um den Schlauch gewickelten Draht oder einer Federklammer fixiert sein,” which Applicant understands to mean that “the chokepoint 5 can for example be

stabilized by a wire wound around the chokepoint 5 or by a spring clip.” Therefore, *Jäger* does not teach the forming of the stent by stabilizing the central portion of the balloon, but by pre-stabilizing the central portion of the stent. In fact, Applicant could find no reference to expansion balloons in *Jäger*.

Applicant notes that such a deficiency in *Jäger* had been discussed in the response to the Office Action of November 11, 2006 and has not been rebutted by the Examiner.

Based on the foregoing, independent claim 1 is not amended either in view of the combinations of *Ruiz* and *Glastra*, or of *Glastra* and *Jäger*. Therefore, none of the claims depending from claim 1, including claims 10 and 22, are obvious in view of the cited references.

Conclusion

In view of the foregoing amendment and comments, Applicant respectfully submits that the application is now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Dated: July 6, 2007

Respectfully submitted,

/Franco A. Serafini/

Franco A. Serafini
Reg. No. 52,207
Attorney for Applicant
LUCE, FORWARD, HAMILTON & SCRIPPS, LLP
11988 El Camino Real, Suite 200
San Diego, California 92130
Tel: (858) 720-6368
Fax: (858) 523-4326